

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.

Q2
(cont)

(ii) grasping the uncoupled portion of the silicone bands extending from the successive sheets; and

(iii) pulling the uncoupled portion of the silicone bands so as to remove the silicone bands and uncover the adhesive strips, thereby irreversibly binding successive sheets together.

REMARKS

Claims 1-7 and 10-21 are pending. The drawings are objected to under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. Claim 14 is rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 1-7 and 10-21 are rejected under 35 U.S.C. § 103(a) as being obvious over Corlew *et al.* (U.S. Patent No. 4,789,187) in view of Delcuve *et al.* (U.S. Patent No. 5,658,629).

In view of the finality of these rejections, Applicants have cancelled Claims 1-6 and 10-18 without prejudice to the prosecution of their subject matter in other patent applications. Claims 7 and 19 are amended as described herein to more clearly set forth the subject matter of Applicant's invention. Copies of these claims, marked to show the amendments, are attached hereto. Further, for the Examiner's convenience, a copy of all pending claims is also attached.

For reasons to be set forth below, it is requested that the objections and rejections be removed and that the claims be allowed to issue.

1. The Drawings Are Correct

The drawings are objected to because, according to the Examiner, they do not show a "wounded" silicone band, where a "wounded" or "wound" band is referred to in claim 13.

Claim 13 is canceled, so that this rejection has been rendered moot, and should be withdrawn. The Examiner has confirmed in the Advisory Action of December 10, 2002 that cancellation of this claim will overcome this objection.

2. The Claims Are Definite

Claim 14 is rejected under 35 U.S.C. §112 as indefinite.

Claim 14 is canceled, so that this rejection is rendered moot, and should be withdrawn. The Examiner has confirmed in the Advisory Action of December 10, 2002 that cancellation of this claim will overcome this rejection.

3. The Claims Are Not Obvious

Claims 1-7 and 10-21 are rejected under 35 U.S.C. §103(a). The Examiner contends that the claims are obvious over United States Patent No. 4,789,187 by Corlew *et al.* ("Corlew") in view of United States Patent No. 5,658,629 by Delcuve *et al.* ("Delcuve"). The Examiner states:

Corlew *et al.* disclose a sheet for binding to one or more sheets and the method thereof including a sheet (11), an adhesive strip (15-self-stick adhesive) along at least one of its edges (lateral edge), a paper backing strip (16) releasably placed on the adhesive; the paper backing strip is released from the adhesive so that the sheet may be attached to a page in a magazine. Adhesives having permanent (pressure-sensitive) and temporary (releasable or repositional) properties are well-known in the art. Even though Corlew recognizes the use of a releasable adhesive for repositioning the sheet in the magazine, it would have been obvious to provide a permanent adhesive on the sheet should the user desire the sheet to permanently retain in a particular position.

The Examiner considers the claim limitations regarding the backing being larger than the adhesive and the number of adhesive bands on the sheets to be obvious variations or matters of design choice. Regarding claim 16, the Examiner states that "the method of applying the band to the sheet does not structurally limit the claim." The Examiner concludes:

Corlew disclose the claimed invention except for the adhesive strip having a silicone band that is wound. Providing a silicone band as a release liner for an adhesive is well-known in the art. Delcuve et al. disclose double-sided silicone coated liners adapted for self-wound tapes for coating adhesives. The silicone paper has an advantageous elongation/shrinkage relationship as compared to glassine-type and film liners. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Corlew's invention to provide the paper backing having a silicone band, as taught by Delcuve, to provide a liner having good dimensional stability at an attractive cost.

In the previously submitted Amendment, Applicant argued that there is no suggestion to produce an essential aspect of the claimed invention, namely permanently binding sheets together, in the cited art. To the contrary, *temporary* binding is a critical component of the Corlew disclosure, which teaches a table of contents which can be removably attached to various pages of a magazine to act as a more stable bookmark (Corlew, column 1, lines 48-50) and to provide the reader with readily accessible content information (Corlew, column 1, lines 39-42). Applicant contended that the claimed invention, which requires permanent binding, cannot be rendered obvious by Corlew and/or Delcuve, which merely teaches a double-sided silicone coated liner.

The Examiner responded to Applicant's arguments by stating: "[a]pplicant argues that Corlew *et al.* fail to disclose permanent binding of the sheet. In response to applicant's arguments, the recitation 'for permanent binding' has not been given patentable weight because the recitation occurs in the preamble."

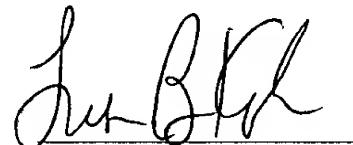
Accordingly, to put the claims in order for allowance, the claims have been amended so that the feature of permanent binding is recited in the body of the claims. In particular, claims 7 and 19 are amended to provide for "irreversibly binding" the sheets.

Therefore, since *non*-permanent binding is a critical feature of Corlew, and Delcuve relates only to a silicone liner, the claims are not obvious, and it is requested that the rejection of the claims under 35 U.S.C. §103 be withdrawn.

4. **Conclusion**

For all the foregoing reasons, it is requested that all the objections and rejections be withdrawn and that the claims be allowed to issue.

Respectfully submitted,



Lisa B. Kole
PTO Reg. No. 35,225
(212) 408-2628

Baker Botts L.L.P.
30 Rockefeller Plaza
New York, NY 10112

CLAIMS MARKED TO SHOW CHANGES

7. (Three times amended) A method for irreversibly binding a plurality of sheets together, comprising:

- (i) superimposing a sheet having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges, and a silicone material band, releasably placed on said glue or adhesive tape strip and having at least a portion not coupled to said glue or adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal over a second sheet;
- (ii) grasping the uncoupled portion of the silicone band; and
- (iii) pulling the uncoupled portion of the silicone band so as to uncover the glue or adhesive tape strip and thereby irreversibly bind the two sheets together.

19. (Amended) A method for irreversibly binding sheets together, comprising:

- (i) superimposing a plurality of sheets, each having an adhesive strip along at least one of its edges and a silicone material band, releasably placed on said adhesive strip and having a portion uncoupled to the adhesive strip and extending beyond the sheet, such that the adhesive strips of successive sheets are superimposed;
- (ii) grasping the uncoupled portion of the silicone bands extending from the successive sheets; and
- (iii) pulling the uncoupled portion of the silicone bands so as to remove the silicone bands and uncover the adhesive strips,
thereby irreversibly binding successive sheets together.

PENDING CLAIMS

7. (Three times amended) A method for irreversibly binding a plurality of sheets together, comprising:

- (i) superimposing a sheet having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges, and a silicone material band, releasably placed on said glue or adhesive tape strip and having at least a portion not coupled to said glue or adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal over a second sheet;
- (ii) grasping the uncoupled portion of the silicone band; and
- (iii) pulling the uncoupled portion of the silicone band so as to uncover the glue or adhesive tape strip and thereby irreversibly bind the two sheets together.

19. (Amended) A method for irreversibly binding sheets together, comprising:

- (i) superimposing a plurality of sheets, each having an adhesive strip along at least one of its edges and a silicone material band, releasably placed on said adhesive strip and having a portion uncoupled to the adhesive strip and extending beyond the sheet, such that the adhesive strips of successive sheets are superimposed;
- (ii) grasping the uncoupled portion of the silicone bands extending from the successive sheets; and
- (iii) pulling the uncoupled portion of the silicone bands so as to remove the silicone bands and uncover the adhesive strips, thereby irreversibly binding successive sheets together.

20. The method of claim 19, further comprising binding the plurality of sheets to at least one sheet that does not have an adhesive strip.
21. The method of claim 19, wherein the sheets to be bound include a binding cover.